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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/619,614	07/19/2000	Makoto Kukita	193236US2	2165

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OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.  
1940 DUKE STREET  
ALEXANDRIA, VA 22314

EXAMINER

SHENG, TOM V.

ART UNIT	PAPER NUMBER
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2673

15

DATE MAILED: 05/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/619,614

Applicant(s)

KUKITA, MAKOTO

Examiner

Tom V Sheng

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 5-7, 12-14 and 17-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 5-7, 12-14, 17 and 18 is/are allowed.
- 6) ☒ Claim(s) 19-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 19 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Young (US Patent 5382962).

As for claims 19 and 20, Young teaches a portable electronic apparatus (handle/controller 4 with a handheld computer 1; see figures 1, 2, 3), comprising a main body (handheld computer 1 and base unit 2) having a display unit (see display part in figure 1) on a surface thereof; and

a holding unit (handle/controller 4) protruding substantially perpendicular from the main body (perpendicular to the bottom surface of the handheld computer/base unit) for holding the portable electronic apparatus (by resting on the palm of a hand) and including a pointing device (cursor ball 5L or 5R) and switches (action switches 6L or 6R) configured to be operated by a same hand holding the holding unit so that the portable electronic apparatus is held and operated with one hand (to be handled and operated by either hand using either one of two arrangements; see column 1, line 60 - column 2, line 6); and

a connector configured to connect the holding unit to the main body such that the

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holding unit is separated from the main body (an inside connector 9 within the handle/controller 4 provides connection to the base unit 2 directly when attached or to the connector chord 10 when detached; see figure 3; column 2, lines 21-31).

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 21 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Young.

As for claims 21 and 24, Young is silent regarding claimed said holding unit is configured to store batteries used to power said portable electronic apparatus. On the other hand, Young teaches batteries storage in side legs 3, inherently for powering his handheld computer in the field. One of ordinary skill in the art would recognize that the batteries could just as easily be installed in the handle/controller 4; moreover, with the batteries in the handle/controller 4, the user would have a more balanced feel holding the computer. Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to incorporate batteries into the handle/controller, thus providing batteries powered operation in the field and with good balance holding the computer.

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5. Claims 22, 23, 25 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Young as applied to claims 1 and 8 above, and further in view of Hartigan (US Patent 6035491).

As for claims 22, 23, 25 and 26, Young teaches a holding unit including a pointing device and switches operable by a same hand. However, Young does not teach that the holding unit is foldable toward a side of the main body, or that power would be supplied/cut-off or in a standby state based on the position of the holding unit. On the other hand, it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify Young's holding unit to be foldable and further having power-on when unit is unfolded and power-off when unit is folded, since some users would prefer to hold the holding unit in an upright fashion when operating the portable electronic apparatus. Further, it would be naturally desired to turn off the apparatus when the holding unit is folded, since the user is not going to use the apparatus in that instance.

As a support, Hartigan shows a foldable device (10) having a flip portion (14) housing a display (18). Naturally, when the flip portion is open, the user is intending to use the device, and when the flip portion is closed, the user is not going to use the device (column 2, lines 1-37). This is similarly true with a foldable cell phone.

***Allowable Subject Matter***

6. Claims 5, 6, 7, 12, 13, 14, 17 and 18 are allowed.

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7. The following is a statement of reasons for the indication of allowable subject matter: none of prior arts of record teaches the recitation "wherein the holding unit includes a grip to be grasped at least with a palm of said one hand such that when a user holds the holding unit with said one hand, the palm of said one hand holding the holding unit is also substantially perpendicular to the main body" of claims 17 and 18, specifically in relation to other limitations of the claims. Claims 5-7 are dependent on claim 17. Claims 12-14 are dependent on claims 18.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tom V Sheng whose telephone number is (703) 305-6708. The examiner can normally be reached on 8:30am - 5:00pm.

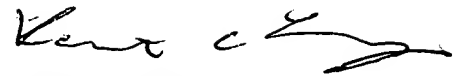
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bipin Shalwala can be reached on (703) 305-4938. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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**KENT CHANG**  
**PRIMARY EXAMINER**

Tom Sheng  
2/12/04